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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER	SOROUSH, LAYLA
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* VALERIE DE LA POTERIE, JEAN MONDET,  
and FREDERIC AUGUSTE

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Appeal 2008-5435<sup>1</sup>  
Application 09/881,097  
Technology Center 1600

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Decided:<sup>2</sup> March 23, 2009

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Before TONI R. SCHEINER, DONALD E. ADAMS, and  
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Heard March 18, 2009.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-10, 12, 13, 15-18, 21-56, and 59.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

#### STATEMENT OF THE CASE

“The present invention relates to a cosmetic composition forming a film which may exhibit . . . good resistance to cold water and removability with hot water, comprising at least one film-forming polymer and at least one thermal transition agent” (Spec. ¶1). Claim 1 is representative of the subject matter on appeal:

1. A cosmetic composition for a keratinous material comprising:  
at least one film-forming polymer; and  
at least one thermal transition agent chosen from semi-crystalline compounds, which undergoes a change of state at a transition temperature, Tt, chosen within a temperature range from 25°C to 80°C, the at least one thermal transition agent being not water-soluble in water maintained at a temperature below the transition temperature, Tt,

wherein the at least one film-forming polymer and the at least one thermal transition agent are present in an amount which is sufficient so that the composition is capable, at the temperature of the keratinous material, of forming a film having a resistance (Rc) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance (Rf) to cold water, maintained at 20°C such that Rf-Rc ≥ 8 minutes, and further

wherein said at least one film-forming polymer and said at least one thermal transition agent are different.

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<sup>3</sup> Claims 57 and 58 have been withdrawn from consideration; claim 20 has been canceled; and claim 19 has been objected to as being dependent on a rejected base claim, but otherwise allowable.

The Examiner rejected claims 1-10, 12, 13, 15-18, 20-56, and 59 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement.

We reverse.

#### ISSUE

Has the Examiner met her initial burden of establishing that the Specification lacks adequate written descriptive support for the genus of semi-crystalline thermal transition agents required by the claims?

#### FINDINGS OF FACT

FF1 The Specification discloses a cosmetic composition for keratinous materials. The cosmetic composition, e.g., mascara, is resistant to removal with cold water, resistant to tears and resistant to perspiration, but is easily removed with plain hot water (Spec. ¶ 6). The composition comprises at least one film-forming polymer, and

at least one thermal transition agent which undergoes a change of state at a transition temperature,  $T_t$ , chosen within a temperature range, for example from 25°C to 80°C, the at least one thermal transition agent being not water soluble . . . in water maintained at a temperature below the transition temperature,  $T_t$ , wherein the at least one film-forming polymer and the at least one thermal transition agent are present in the composition . . . [in] an amount, for example, sufficient so that the composition is capable, at the temperature of the keratinous materials, of forming a film having a resistance ( $R_c$ ) to hot water, maintained at 40°C, of less than or equal to 15 minutes and a resistance ( $R_f$ ) to cold water, maintained at 20°C, such that  $R_f - R_c \geq 8$  minutes . . .

(Spec. ¶ 9).

FF2 The Specification teaches that cosmetic “removal with hot water can be obtained using . . . [a] thermal transition agent which undergoes a change of state at a temperature,  $T_t$ , chosen within a temperature ranging . . . from 25°C to 80°C” (Spec. ¶ 19), because the “thermal transition agent above its thermal transition temperature,  $T_t$ , and after its change of state occurs, may make the film more water-sensitive” (*id.* at ¶ 20). “That is, the film of make-up becomes brittle on contact with hot water and . . . readily disintegrates or detaches” (*id.*).

FF3 The thermal transition agents may be crystalline or semi-crystalline (Spec. ¶ 22). Suitable semi-crystalline thermal transition agents may be, “[f]or example, . . . polycaprolactones chosen from  $\epsilon$ -caprolactone homopolymers” (*id.* at ¶ 28). “[P]olycaprolones sold under the name CAPA® 240, 223, 222, 217, 215, 212, 210 and 205 by the company Solvay, and PCL-300 and PCL-700 by the company Union Carbide may be used, for example” (*id.* at ¶ 29).

FF4 Appellants claim a cosmetic composition comprising at least one film-forming polymer; and at least one semi-crystalline thermal transition agent which has a transition temperature,  $T_t$ , between 25°C to 80°C, and which is not water-soluble in water maintained below  $T_t$ , wherein the film-forming polymer and the thermal transition agent are present in an amount which is sufficient so that the composition is capable of forming a film having a resistance ( $R_c$ ) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance ( $R_f$ ) to cold water, maintained at 20°C such that  $R_f - R_c \geq 8$  minutes (claim 1).

#### PRINCIPLES OF LAW

“The ‘written description’ requirement serves a teaching function, . . . in which the public is given ‘meaningful disclosure in exchange for being

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excluded from practicing the invention for a limited period of time.””

*University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922 (Fed. Cir. 2004) (citation omitted). Another “purpose of the ‘written description’ requirement is . . . [to] convey with reasonable clarity to those skilled in the art that, as of the filing date [ ], [the applicant] was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (emphasis omitted).

The first paragraph of § 112 does not require a description of the complete structure of every species within a chemical genus. *See Utter v. Hiraga*, 845 F.2d 993, 998 (Fed. Cir. 1988) (“A specification may, within the meaning of 35 U.S.C. § 112, ¶ 1, contain a written description of a broadly claimed invention without describing all species that claim encompasses.”). Rather, the written description requirement is satisfied when the specification “set[s] forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed.” *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 928 (Fed. Cir. 2004).

The degree of specificity required to adequately describe an invention “varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence.” *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005). In general, the written description requirement may be satisfied by “a precise definition, such as by structure, formula, chemical name, or physical properties[.]” *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993). Whether or not a specification satisfies the requirement is a question of fact, which must be resolved on a case-by-case basis (*Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed. Cir. 1991)).

Finally, it is the examiner's "initial burden [to] present[ ] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims" (*In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976)).

#### ANALYSIS

The Examiner finds that the Specification's disclosure of several species of polycaprolactones does not "provide evidence of possession" of the genus of semi-crystalline thermal transition agents required by the claims (Ans. 4). The Examiner acknowledges that "[t]here are [other] semi-crystalline polymers that would be encompassed by the claim[s]" (*id.*), but finds that "[t]here is no identification of any structures or structural elements (e.g. monomers) that this compounds must possess" (*id.*), other than "certain physical properties" (*id.*), thus, "the claim does little more than define the claimed invention by function" (Ans. 5).

Appellants contend that "an adequate written description 'requires a precise definition, such as by structure, formula chemical name, or physical properties.'" (Reply Br. 3). Appellants contend that "[s]uch a precise definition is in fact provided in the present application, in the form of [three] physical properties . . . . Specifically, the claimed 'at least one thermal transition agent' is defined by 1) its semi-crystalline nature, 2) its transition temperature range, and 3) its lack of water solubility below the transition temperature" (Reply Br. 3).

Appellants have the better argument. One purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that Appellants were in possession of the invention as of their filing date. *See Vas-Cath*, 935 F.2d at 1563-64. The Specification reasonably conveys to one of ordinary skill in the art that a cosmetic

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composition resistant to cold water, but removable with hot water, can be obtained by including in the composition a thermal transition agent with specific physical properties: a transition temperature between 25°C to 80°C, and insolubility in water below its transition temperature (FF1-2).

Moreover, the Specification reasonably conveys that polycaprolactones are merely examples of a larger genus of semi-crystalline thermal transition agents, defined by their physical properties, and whose physical properties make them suitable for the claimed compositions (FF3). The Examiner has not explained why a genus defined by physical properties requires disclosure of additional examples nor why the generic disclosure of semi-crystalline transition agents coupled with the specific examples of polycaprolactones is insufficient for persons of skill in the art to have recognized with reasonable clarity that the inventors possessed what is claimed.

#### CONCLUSIONS OF LAW

The Examiner has not met her initial burden of establishing that the Specification lacks adequate written descriptive support for the genus of semi-crystalline thermal transition agents required by the claims.

REVERSED

Ssc:

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